



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

M/K

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/287,631	04/07/99	EBY	J 03063.0396-0

IM62/0712
FINNEGAN HENDERSON FARABOW GARRETT
& DUNNER
1300 I STREET NW
WASHINGTON DC 20005

EXAMINER

KUHNS, A

ART UNIT	PAPER NUMBER
----------	--------------

1732

17

DATE MAILED: 07/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

BEST AVAILABLE COPY

Office Action Summary

Application No.

09/287,631

Applicant(s)

EBY ET AL.

Examiner

K UHNS

Group Art Unit

1732

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on MAY 16, 2000

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 25-26 AND 33-47 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 25-26 AND 33-47 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

BEST AVAILABLE COPY

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1732

BEST AVAILABLE COPY

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 25-26 and 33-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese reference 1-110123 as set forth in the rejection of claims 25-26 and 33-46 in the previous Office action. The first layer of the Japanese reference comprises foam, as in amended claim 25. The Japanese reference also at least suggests embossing mechanically when the second layer is in a softened condition, as in amended claim 26, because it teaches at page 8, lines 5-9 that the foamed layer is re-heated to a temperature equal to or lower than the foaming temperature and it is also taught at page 7, lines 14-18 that a surface treated layer may already be present on the foamed layer and thus one of ordinary skill in the art would have recognized that this layer would have been also subject to re-heating. It is submitted that the second or surface treated layer of the Japanese reference is subject to wear, as in claim 47.

3. Applicants' arguments filed May 16, 2000 have been fully considered but they are not persuasive. Applicants arguments are focused on relative chemical and mechanical embossing depths. Applicants argue that the examiner ignores the upper depth of unevenness which is 2.0 mm and that such a depth would tend to create a mechanical embossing depth greater than the chemical embossing depth, considering that the foam layer has a protruding thickness of less than 2.0 mm. The examiner disagrees. The Japanese reference teaches at page 4, lines 16-18 that the layer

Art Unit: 1732

BEST AVAILABLE COPY

containing foaming agent may be as thick as 0.3 mm and at page 7, line 10 teaches that the foaming may be “almost eight times”, implying a resulting thickness of almost 2.4 mm or an embossment of almost 2.1 mm (relative to the initial thickness of 0.3 mm), which is greater than the upper limit of 2.0 mm on the mechanical embossing depth.

Applicants’ arguments concerning specific examples of the Japanese reference are noted by the examiner, but it is the examiner’s position that the relevant teachings of this reference are not limited to what is disclosed in the examples. The examiner also does not agree with applicants’ assertion that the Japanese reference teaches away from the claimed invention, for reasons of record.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 1732

BEST AVAILABLE COPY

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is (703) 308-3462. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Silbaugh, can be reached on (703) 308-3829. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Allan R. Kuhns

ALLAN R. KUHN
PRIMARY EXAMINER
~~GROUP 1309~~ AU 1732

7-11-00